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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,905	12/14/2000	Jonathan Cass	H310177US	5749

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EXAMINER
BEACHAM, CHRISTOPHER R

ART UNIT	PAPER NUMBER
2653	

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/735,905	CASS, JONATHAN	
	Examiner	Art Unit	
	Christopher R. Beacham	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 July 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,4,6 and 7* is/are pending in the application.

4a) Of the above claim(s) *2 and 5* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,4,6 and 7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☑ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 3, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Golden et al. (hereinafter Golden) (US 3,878,751).

- Regarding claim 1, Golden discloses a turntable record 16 having multiple tracks having at least one scale of notes and/or series of chords of a predetermined musical key, the scale being diatonic, pentatonic, whole tone or one of the modes (col. 3, lines 7-45; col. 4, lines 31-34), the notes and/or chords on each track each lasting for a predetermined time with silence for a predetermined time between adjacent notes and/or chords (col. 4, lines 58-63; see Figure 4), and the predetermined time for which the notes and/or chords last on one track being different from the predetermined times for which the notes and/or chords last on the other tracks (col. 8, lines 20-26).

- Regarding claim 3, Golden teaches at least one record track being provided with a scale of notes in their natural order (col. 3, lines 40-46).

- Regarding claim 4, Golden teaches at least one track being provided with a scale of notes in a random order (col. 4, lines 21-34).

- Regarding claim 6, Golden shows the track and the other track are unconnected (see attached Figure 3).

Claim Rejections – 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bryant (US 802,135).

- Regarding claims 1, 3 and 4, Bryant discloses a turntable record having a track for storing information. In column 1, lines 33-43, Bryant discusses that each circle on the record is made up of single or sustained tone. As shown in Bryant's figure, a period of silence occurs for a predetermined time between each concentric circle.

Further, the limitations drawn to the particular information recorded on the disk are not functionally related to either the turntable record or the record player and are therefore not given any patentable weight.

Alternatively, even if one were to give the limitations patentable weight, it would have been obvious to one of ordinary skill in the art at the time the invention was made to record musical information with a scale of notes, wherein the scale is diatonic, pentatonic, whole tone or one of the modes on a turntable record.

The rationale is as follows: One of ordinary skill in the art at the time of the invention would have been motivated to provide the turntable record of Bryant with musical information as claimed because it is desirable to record information on a turntable record so that it can be played back at a later time.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golden et al. (hereinafter Gordon) (US 3,878,751) as applied to claims 1 and 5 above, and further in view of Porter (US 1,425,281).

- Regarding claim 7, Golden discloses all the features except the track being connected to an adjacent track. Porter teaches a track being connected to an adjacent track (pg. 1, lines 61-73).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to connect the turntable record tracks of Golden in the manner as taught by Porter.

The rationale is as follows: One of ordinary skill in the art at the time of the invention would have been motivated to connect the turntable record tracks of Golden in the manner as taught by Porter in order to play a plurality of selections or parts of selections without necessitating resetting of the phonograph stylus (Porter, pg. 1, lines 11-15).

Response to Arguments

Applicant's arguments filed 7/30/2003 have been fully considered but they are not persuasive:

- First, Applicant states on page 3 :

> *"Page 3, paragraph 0010 of the specification describes the use of the record on a conventional turntable with a swing arm and needle. The record in accordance with the present invention is of greater advantage to a disk jockey than prior art records used in a similar manner by reason of the physical characteristics of the notes and/or chords on each track and the differences therebetween from one track to another."*

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *use of the record on a conventional turntable with a swing arm and needle*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

- Second, Applicant continues on page 3:

  "*There is no disclosure or suggestion in Golden of a record as now defined in Claim 1 as amended.*"

The Examiner maintains that Golden '781 discloses the claimed invention as amended in section 1 above.

The rejection of claim 1, along with the remaining claims that depend on claim 1, is maintained.

- Last, the Applicant asserts on page 4:

  "*However, there is no disclosure or suggestion in Bryant of applicant's record which has the notes and/or chords on each track each lasting for a predetermined time with silence for a predetermined time between adjacent notes and/or chords, and with the predetermined time for which the notes and/or chords last on one track being different from the predetermined times for which the notes and/or chords last on the other tracks.*"

Bryant (US 802,135) discloses a turntable record having a track for storing information. In column 1, lines 33-43, Bryant discusses that each circle on the record is made up of single or sustained tone. As shown in Bryant's figure, a period of silence occurs for a predetermined time between each concentric circle.

Further, the limitations drawn to the particular information recorded on the disk are not functionally related to either the turntable record or the record player and are therefore not given any patentable weight.

Alternatively, even if one were to give the limitations patentable weight, it would have been obvious to one of ordinary skill in the art at the time the invention was made to record musical information with a scale of notes, wherein the scale is diatonic, pentatonic, whole tone or one of the modes on a turntable record.

The rationale is as follows: One of ordinary skill in the art at the time of the invention would have been motivated to provide the turntable record of Bryant with musical information as claimed because it is desirable to record information on a turntable record so that it can be played back at a later time. Therefore, the rejection of claims 1, 3 and 4 is upheld.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Beacham whose telephone number is (703) 605-4256. The examiner can normally be reached on M-F, 8: 00 am-5: 30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (703) 305-6137. The fax phone

number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Christopher R. Beacham
Patent Examiner
Art Unit 2653
September 29, 2003

WILLIAM KORZUCH
SUPERVISORY PATENT EXAMINER
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